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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,678	08/20/1999	MARY K. MCCARTY	1002JJ-35352	9419

7590 01/30/2002

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/378,678

Applicant(s)

MCCARTY ET AL.

Examiner

Robert M. Pond

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Folding the mailer as described results in recipient's address being concealed and therefore undeliverable via the mail system. Claim language is inconsistent with terminology used in specification to identify mailer sides.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2165

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-20, and 27-29 are rejected under U.S.C. 102(e) as being anticipated by Dodd, patent number 6,321,211.

Dodd teaches all limitations of claims 1-20 and 27-29. For example, Dodd discloses an online system, method, and article of manufacture that produces a combined gift certificate and greeting card whereby the combined certificate and card are mailed electronically to the recipient's email address. The actual certificate or coupon is mailed through the traditional postal system. Dodd teaches a graphical user interface displayed on a remote user computer used to select from a plurality of merchants and locations, the desired gift certificates, amounts, style of greeting card, and sentiment (see at least abstract; Fig. 1a (100); Fig. 2a (100); col. 1, line 59 through col. 2, line 51; col. 9, lines 49-51).

Inherent in the system and method of Dodd is the capability to offer as a gift item

is a card of value from a particular merchant and if selected as a gift, would be mailed by the same means as the printed certificate or coupon.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-26 are rejected under U.S.C. 103(a) as being unpatentable over Dodd, in view of Spector, patent number 5,870,718.

Dodd teaches all the above and including the mailing of the actual certificate or coupon through the traditional postal system, but fails to disclose details regarding printing the combined card and certificate and method of folding.

Spector teaches an online system for producing a composite greeting and gift certificate card that is mailed to the recipient using the traditional postal system (see at least abstract; Fig. 1(C-P, 10); col. 2, line 35 through col. 3, line 7).

Spector teaches a combined card and certificate printed on one side and perforation to separate the certificate from the social sentiment created by the sender (see at least Fig. 2 (GS, CS); col. 4, lines 1-13). This examiner takes the position that double-sided printing for the purpose of printing addresses on the opposite side is well known in the art. Therefore it would have been obvious to

Art Unit: 2165

one of ordinary skill in the art at time of the invention to modify the system and method of Dodd to include the combined card and certificate as taught by Spector, in order to provide a more personal touch for the occasion in the form of a physical card and gift.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,513,117 (Small) 30 April 1996; teaches electronically dispensing personalized greeting cards and gifts, and includes a locator service.
- "GiftPro.com Makes Sending a Gift Certificate From Many Major Retailers and Restaurants Easy," Business Wire, 25 May 1998, Dialog file 20, 01711048; teaches a national online service that combines gift certificates with a greeting card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344.

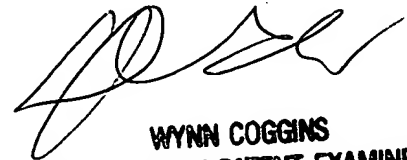
The fax phone numbers for the organization where this application or proceeding

Art Unit: 2165

is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

RMP
January 24, 2002



WYNN COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100